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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/614,016

07/08/2003

Marie-Laure Delacour

05725.1224-00

9511

22852

7590

06/23/2010

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EXAMINER

CHANNAVAJJALA, LAKSHMI SARADA

ART UNIT

PAPER NUMBER

1611

MAIL DATE

DELIVERY MODE

06/23/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/614,016	Applicant(s) DELACOUR ET AL.	
	Examiner Lakshmi S. Channavajjala	Art Unit 1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 8-20, 22, 25-51 and 57-63 are is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8-20, 22, 25-51 and 57-63 are is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3-29-10</u> . | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

Receipt of IDS dated 3-29-10, response and declaration under 37 CFR 1.132 dated 3-29-10 is acknowledged.

Claims 1-4, 8-20, 22, 25-51 and 57-63 are pending in the instant application. Examiner herewith clarifies that claims 5, 21, 23 and 24 have been canceled.

The following rejection of record has been maintained:

Double Patenting

Claims **1-5, 8-51 and 57-63** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-63 of U.S. Patent No. 6,689,345 in view of US 4,710,375 or in view of US 5,486,354.

Instant claims recite a cosmetic composition comprising a binder comprising water and particles of cross-linked elastomeric organosiloxane (phase C), and a particulate phase (phase B), with the ratio of 0.4:1 to 1.8:1 and the ratio of the binder to the phase B is from 1:1 to 2.5:1. The composition of the instant claims comprise particulate phase B comprises at least one pearlescent agent, present in an amount ranging from 10% to 50% by weight, relative to the total weight of the composition and has a pasty to pulverulent texture.

The patented claims recite a make-up composition wherein the composition comprises particles of elastomeric organosiloxane suspended in water phase and the patented composition is also used for the same cosmetic purposes claimed in the instant application. Dependent claims of the cited patent

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recite the particle sizes of the organosiloxane, aqueous phase gelling agents, fatty substances, waxes, and volatile oils etc., all of which are recited in the instant claims. Further, the dependent claims of the patent (48-54) recite fillers, nacles and pigments respectively, which are defined by the patent as particulate materials and include the claimed fillers and pigments respectively and include the same materials that are claimed in the instant applications. Furthermore, the patent claims same cosmetic forms or products such as solid foundation powders that read on the claimed pulvurulent mixtures, foundation etc., that are within the scope of the instant claims. While the patented claims do not recite the exact ratios of the instant claims, they recite the amounts of the organopolysiloxane and the particulate phase (see claims 11-12 and 33-34), particle sizes and hardness range that is within the claimed ranges and also suggest different consistencies or forms of the cosmetic composition such as powders, sticks. Accordingly, preparing a cosmetic/make up composition of desired consistency or form such as powder or foundation or stick form by choosing the appropriate amounts of the individual components i.e., polyorganosiloxane, particulate phase, water and other components claimed in '345 it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to optimize the amounts or ratios of the polyorganosiloxane and the particulate phase because the patented composition is used to prepare the same cosmetic products that are also claimed in the instant application.

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With respect to the pearlescent pigments and their amounts claimed in the instant particulate phase, the said patent (see claim 46) recites pigment separate from the aqueous phase but fails to recite pearlescent pigments.

US 375 patent teaches cosmetic compositions comprising pearlescent pigments in cosmetic products for imparting pearlescent effect to the compositions and gives long lasting makeup (abstract, col. 2, col. 8, L 6-12, table 1, col. 10, L 52-67). The composition of '375 patent are in the form of eye, skin or lip care compositions (col. 1, L 35-45). US 375 suggests the amount of pigment as high as 20-95% (col. 11, L 1-7), more particularly 6% to 64% (col. 12, L 3-21) for superior properties (table 2) suggests that the pearlescent pigments are easily dispersed in the composition, non-toxic, non-irritating to skin and impart a metallic luster that is soft and satiny.

Alternatively, 354 patent also teaches cosmetic composition comprising pearlescent pigments confers excellent cosmetic properties such as pearliness and smoothness (col. 1). The composition is in the form of powders, sticks, blush etc., in the form of paste or powder (col. 2, col. 3, L 7-12). For the amount of the pigment, US 354 teaches 0.5 to 30% of the total composition (see claim 1 of the patent).

Thus, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to prepare cosmetic products such as sticks, foundation or other forms such as those described in the patented claims of US 345 and incorporate pearlescent pigments of US 375 or US 354 in amounts 20-95% or 0.5-30% depending on the desired pearling effect because both US 375

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and US 354 suggests that the pearlescent pigments in the described amounts impart transfer resistance, water repellency, shine, satiny or pearling effect to the cosmetic composition. US 354 also suggest that the pearlescent pigments also impart transparency as opposed to the conventional pigments that impart whitening upon application.

Claims **1-5, 8-51 and 57-63** are directed to an invention not patentably distinct from claims 1-63 of commonly assigned US 6,689,345. Specifically, the patent method recites a composition that renders the instant composition obvious for the reasons mentioned above.

The U.S. Patent and Trademark Office normally will not institute interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned 6,689,345, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C.

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103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-5, 8-20, 22, 25-51 and 57-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over US patents 6,403,704 ('704) or US 6,689,345 ('345) or US 6,565,862('862) each in view of US 4,710,375 or in view of US 5,486,354.

'704 teach cosmetic skin care compositions comprising particles of at least a partially crosslinked elastomeric polyorganosiloxanes suspended in an aqueous phase, wherein the polymer dryness as well as a matte finish to the cosmetic composition when applied (col. 2, L 23- 59). Both instant specification and '704 refer to the same polysiloxane compounds described in JP-A-10/175816 application (mentioned in the instant application) for the suitable polyorganosiloxanes compounds that are suitable for the instant invention, particularly, those sold under the trade names BY-29-122, BY-29-119 (also disclose in the instant specification) (col. 3, L 37-59 & col. 4, L 10-40) having the same hardness and particle sizes recited in the instant claims. For microcrystalline wax of claims 32 -35, see col. 5, L 50-55. For volatile oils of

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claims 36-38, see col. 4, last paragraph through col. 5. For gelling agents of claims 39-43, see col. Col. 6, l 4-40. For the pigments, fillers and nacles (read on instant pearlescent agents) see entire col. 7. '704 teach preparing the composition by a screw extruder mixer and thus meet claimed method of preparing the composition (claims 51-60), where the polyorganosiloxanes is added to water and mixing with the pigment or filler materials that are particulate in nature. '704 further teach the same solid compositions claimed (col. 49-59). '704 do not teach the claimed ratios of the particulate phase and binder. However, '704 teach the percentages of the organosiloxane polymer, pigments, fillers or nacles and further teach the composition for the same purpose i.e., cosmetic or make up products such as a foundation, eye shadow etc., as in claims 58. Further, '704 teach that the composition provides advantages such as homogeneity, stability, matte finish, and freshness and water resistance.

'862 also teach cosmetic composition comprising the claimed binder and particulate material and for the preparation of the same cosmetic compositions such as those claimed. The disclosure of '862 and '704 are similar in that the former also teach the same polymers as suitable for binder phase, and also teach the fillers, pigments, nacles, fatty phase, waxes and gelling agents etc. '862 also describe the same advantages such as those described by '704 with the composition. '862 fail to teach the claimed ratios or percentages of the components A, B and C. However, '862 teach the percentages of the

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organosiloxane polymer, pigments, fillers or nacles and further teach the composition for the same purpose i.e., cosmetic or make up products such as a foundation, eye shadow etc., as in claims 58. '862 also teach pearlescent agents in an amount of 2-15% (col. 7, L 43-50). Further, '862 teach that the composition provides advantages such as homogeneity, stability, matte finish, and freshness and water resistance. Therefore it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to optimize the amounts of the silicone polymer and other components such as particulate materials, fatty phase, gelling agents etc., with an expectation to achieve a stable cosmetic product that provides a matte finish and freshness.

'345 cosmetic compositions comprising the claimed organosiloxane elastomeric polymers (col. 4, L 55 through col. 6, L 67) and are similar to those of '704 and '862. '345 also teach the claimed fatty phase, particle sizes (col. 7), containing microcrystalline wax (col. 8, L 56-65), gelling agents (col. 8, L 38 through col. 9, L 20), particulate pigments, fillers, nacles (col. 9) and the same method of producing the composition (twin screw extruders- col. 10). '345 fail to teach the claimed ratios or percentages of the components A, B and C. However, '345 teach the percentages of the organosiloxane polymer, pigments, fillers or nacles and further teach the composition for the same purpose i.e., cosmetic or make up products such as a foundation, eye shadow etc., as in claims 58 and teaches etc., in the form of paste or powders (see col. 1, lines 19-27 and col. 4, line 51). Further, '345 teach that the composition provides advantages such as homogeneity, stability, matte finish, and freshness and water resistance.

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Therefore, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to optimize the amounts of the silicone polymer and other components such as particulate materials, fatty phase, gelling agents etc., with an expectation to achieve a stable cosmetic product that provides a matte finish and freshness.

While US '345 and '704 does not specifically teach pearlescent pigments and their amounts, US 862 teach pearlescent agents in an amount of 2-15% (col. 7, L 43-50), as opposed to instant 10% to 50%. While the amounts of '862 taught overlaps with the instant claimed amounts, one cannot immediately envisage the cosmetic compositions with claimed amounts of pearlescent agents from the composition.

US 375 patent teaches cosmetic compositions comprising pearlescent pigments in cosmetic products for imparting pearlescent effect to the compositions and gives long lasting makeup (abstract, col. 2, col. 8, L 6-12, table 1, col. 10, L 52-67). The composition of '375 patent are in the form of eye, skin or lip care compositions (col. 1, L 35-45). US 375 suggests the amount of pigment as high as 20-95% (col. 11, L 1-7), more particularly 6% to 64% (col. 12, L 3-21) for superior properties (table 2) suggests that the pearlescent pigments are easily dispersed in the composition, non-toxic, non-irritating to skin and impart a metallic luster that is soft and satiny.

Alternatively, 354 patent also teaches cosmetic composition comprising pearlescent pigments confers excellent cosmetic properties such as pearliness

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and smoothness (col. 1). The composition is in the form of powders, sticks, blush etc., in the form of paste or powder (col. 2, col. 3, L 7-12). For the amount of the pigment, US 354 teaches 0.5 to 30% of the total composition (see claim 1 of the patent).

Thus, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to prepare cosmetic products such as sticks, foundation or other forms such as those described in the cosmetic compositions of US 345, US 862 or US '704 and incorporate pearlescent pigments of US 375 or US 354 in amounts 20-95% or 0.5-30% depending on the desired pearling effect because both US 375 and US 354 suggests that the pearlescent pigments in the described amounts impart transfer resistance, water repellency, shine, satiny or pearling effect to the cosmetic composition. US 354 also suggest that the pearlescent pigments also impart transparency as opposed to the conventional pigments that impart whitening upon application. All of the cited references are directed to same type of cosmetic compositions with a desire to impart excellent finish and luster and hence constitute analogous art.

Claims **1-5, 8-51 and 57-63** are rejected under 35 U.S.C. 103(a) as being unpatentable over US EP 1064930 (EP) in view of US 4,710,375 or in view of US 5,486,354 or JP 2000103717 (JP 717, abstract only) in view of EP and one of US 375 or US 354.

The examiner relies on US Patent 6,689,345 for the English translation of EP reference because the US patent 345 relies on the EP application for foreign priority. The teachings of US 345 have been discussed in the preceeding rejection (#4). Accordingly, for the reasons mentioned above, it would have been obvious for a skilled artisan at the time of the instant invention to optimize the amounts of the silicone polymer and other components such as particulate materials, fatty phase, gelling agents etc., with an expectation to achieve a stable cosmetic product that provides a matte finish and freshness because '345 teach the percentages of the organosiloxane polymer, pigments, fillers or nacles and further teach the composition for the same purpose i.e., cosmetic or make up products such as a foundation, eye shadows etc., in the form of paste or powders (see col. 1, lines 19-27 and col. 4, line 51).

Alternatively, JP (abstract) teaches a solid cosmetic composition having excellent stability to impact even when mixing a large amount of spherical powder of an organopolysiloxane elastomer (abstract). The composition of JP comprises 0.1% to 50% by wt of organopolysiloxane spherical powder having 50-100 or 50-80 JIS hardness and a particle size of 0.1-200 microns. JP teaches preparing the cosmetic in the form of powdery foundation, or other kinds of foundations, rouges etc., and teaches preparing the spherical powder by dispersing organopolysiloxane in water. JP fails to teach the claimed particulate phase B in the composition and the additional components claimed in the instant application i.e., fillers, pearlescent materials, oils, wax, gelling agents etc. of the instant claims.

US 375 patent teaches cosmetic compositions comprising pearlescent pigments in cosmetic products for imparting pearlescent effect to the compositions and gives long lasting makeup (abstract, col. 2, col. 8, L 6-12, table 1, col. 10, L 52-67). The composition of '375 patent are in the form of eye, skin or lip care compositions (col. 1, L 35-45). US 375 suggests the amount of pigment as high as 20-95% (col. 11, L 1-7), more particularly 6% to 64% (col. 12, L 3-21) for superior properties (table 2) suggests that the pearlescent pigments are easily dispersed in the composition, non-toxic, non-irritating to skin and impart a metallic luster that is soft and satiny.

Alternatively, 354 patent also teaches cosmetic composition comprising pearlescent pigments confers excellent cosmetic properties such as pearliness and smoothness (col. 1). The composition is in the form of powders, sticks, blush etc., in the form of paste or powder (col. 2, col. 3, L 7-12). For the amount of the pigment, US 354 teaches 0.5 to 30% of the total composition (see claim 1 of the patent).

Thus, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to prepare cosmetic products such as sticks, foundation or other forms such as those described in the cosmetic compositions of EP and incorporate pearlescent pigments of US 375 or US 354 in amounts 20-95% or 0.5-30% depending on the desired pearling effect because both US 375 and US 354 suggests that the pearlescent pigments in the described amounts impart transfer resistance, water repellency, shine, satiny or pearling effect to the cosmetic composition. US 354 also suggest that the pearlescent pigments also

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impart transparency as opposed to the conventional pigments that impart whitening upon application. All of the cited references are directed to same type of cosmetic compositions with a desire to impart excellent finish and luster and hence constitute analogous art.

It would have been obvious for a skilled artisan at the time of the instant invention to include the cosmetic additives such as fillers, pearlescent materials, oils, wax, gelling agents etc. of EP (US 345) depending on the desired consistency and effect, in the composition of JP because both JP and EP are directed to preparing the same type of cosmetic compositions comprising the same type of organopolysiloxane materials (including hardness and particle sizes) and according to EP the instant claimed materials are conventionally used in preparing the described cosmetic make up compositions such as foundations, powders etc. With respect to the claimed ratios, as explained above, '345 teach the percentages of the organosiloxane polymer, pigments, fillers or nacles and further teach the composition for the same purpose i.e., cosmetic or make up products such as a foundation, eye shadows etc., in the form of paste or powders (see col. 1, lines 19-27 and col. 4, line 51) and JP also teaches percentages of organopolysiloxanes, both for preparing the same type of compositions i.e., powdery foundations etc. Therefore, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to optimize the amounts of the silicone polymer and other components such as particulate materials, fatty phase, gelling agents etc., with an expectation to achieve a stable cosmetic product that provides the desired finish and strength.

Further, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to prepare cosmetic products with the organosiloxanes of JP containing additives, pigments and fillers of EP, and also incorporate pearlescent pigments of US 375 or US 354 in amounts 20-95% or 0.5-30% depending on the desired pearling effect because both US 375 and US 354 suggests that the pearlescent pigments in the described amounts impart transfer resistance, water repellency, shine, satiny or pearling effect to the cosmetic composition. US 354 also suggest that the pearlescent pigments also impart transparency as opposed to the conventional pigments that impart whitening upon application. All of the cited references are directed to same type of cosmetic compositions with a desire to impart excellent finish and luster and hence constitute analogous art.

Response to Arguments

Applicants' arguments filed on 3-29-10 have been considered but not found persuasive. Applicants argue that independent claims 1, 59, 62, and 63 recite several ratios and amounts that the Examiner concedes are not taught by the cited references. It is argued that the examiner concedes that the cited '345, '704 and '862 patents do not teach the claimed ratio or percentages and attempts to rectify the deficiencies, specifically, the deficiencies with regards to the amount of pearlescent agents, with '345 and '375 patents. However, it is argued that a

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person of skill in the art would not arrive at the instant claimed invention with reasonable expectation of success because of the unpredictability in the art. In support of their argument, Applicants submit that the Declaration under 37 C.F.R. § 1.132 of Marie-Laure DELACOUR ("the Delacour Declaration") previously submitted on December 8, 2008, and the Declaration of Jean-Louis MATTEI ("the Mattei Declaration"), submitted herewith, and argue that the declarations highlight the unpredictability in the art. Applicants assert that the Delacour Declaration demonstrates that inventive Compositions 1 and 4 "exhibit a pulverulent-to-pasty texture and are sufficiently elastic and deformable such that their shapes can be easily modified, for example, manually, without exudation," and "are sufficiently solid and cohesive such that they can retain the cylindrical shape obtained upon extrusion and can be left in the cylindrical shape at ambient temperature and pressure without changing shape, for at least three hours" (pages 4-5 of the Delacour Declaration). In contrast, comparative compositions 2 and 3 are "fragile, crumbly powders, which are unable to maintain the cylindrical shape obtained upon extrusion for any length of time" (page 5 of the Delacour Declaration).

Applicants' arguments regarding the Delacour declaration have been addressed in the office action dated 3-18-09 and 6-26-09 and are incorporated herewith. In particular, with respect to the results provided in the declaration under 37 CFR 1.132 of Marie-Laure Delacour, the examiner has considered the declaration, which is not found persuasive because the results presented in the declaration are not of the same scope of the instant claims. Instant claim 1

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requires a particulate phase which is very broad and the dependent claims such as claims 16-30 require the presence of at least one particulate material. The claimed invention requires one particulate material in combination with any organopolysiloxane C, whereas the composition in the declaration tested includes a specific organopolysiloxane BY29119 in combination with a specific particulate phase made of several materials such titanium oxide, yellow iron oxide, black iron oxide, nylon powder and brown/yellow iron oxide. Thus, the composition employed in the comparative tests is not representative of the broad scope of the claimed invention.

Applicants argue that the examiner's statement that instant claimed ratios and percentages would have been optimized by a skilled artisan is inaccurate as shown by the Mattei Declaration. It is argued that the declaration shows that comparative compositions comprising identical amounts of water have a different texture depending on the amount of pearlescent agent in the composition. It is argued that comparative compositions 1, 2 and the inventive composition 2 all contain 28% water and yet if the pearlescent agent outside the claimed range (as in comparative compositions 1 and 2), result in a fragile, crumbly cylinder. On the other hand using pearlescent agent instead of talc, with an identical amount of water, results in a pasty cylinder (inventive composition 2). It is further argued that the inventive composition 3 and comparative composition 3 both have 18.5% water and yet have different textures.

The declaration filed by Mattei under 37 CFR 1.132 have been considered but not found persuasive because according to the declaration and applicants'

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argument it is the replacement of talc by the pearlescent agent results in a pasty cylinder. Instant claims do not exclude talc nor do they recite the replacement of talc with pearlescent agents. Instead, claim 26 includes fillers such as talc. Thus, it is not clear if the pasty texture is due to the substitution of talc with pearlescent agent or occurs even in the presence of talc. Further, while instant claims (except claim 22) do not recite any particular agent and instead only recites "pearlescent agents", the declaration does not provide the unexpected advantage with any type of pearlescent agent and in the amounts claimed. As explained with the previous declaration, instant claims also recite the broad genus organopolysiloxane whereas the comparisons include a specific organopolysiloxane, BY 29119. Furthermore, the ratios of components A/B and B/C tested in the declaration represent a single ratio of the said components, whereas the claims are directed to a range of the ratios. The comparisons do not include ratios outside the claimed range other than the complete absence of pearlescent agents. Whether the unexpected results are the result of unexpectedly improved results or a property not taught by the prior art, the "objective evidence of nonobviousness must be commensurate in scope with the claims which the evidence is offered to support." In other words, the showing of unexpected results must be reviewed to see if the results occur over the entire claimed range. In re Clemens, 622 F.2d 1029, 1036, 206 USPQ 289, 296 (CCPA 1980). Therefore, any argued advantage cannot be reasonably extrapolated to the entire scope of the claimed range of A/B or B/C.

If applicants' argument regarding unpredictability were to be true, then it is the position of the examiner that for the same reason of unpredictability, the results of the said declaration cannot be extrapolated to the entire scope of the claims 1, 59, 62, and 63 and further to the claims that are outside the scope of the compositions employed in testing (declarations).

Applicants argue the cited patents do not suggest or provide any guidance regarding the desirability of the claimed ratios. Instead, they teach the amounts of the organopolysiloxane and particulate phases in terms of widely varied percentage. This deficiency is not rectified by the '375 or the '354 patent. Accordingly, it is argued that as the Mattei declaration further demonstrates the unpredictability in the art, there is no prima facie case of obviousness. It is argued that the '862 and '345 patents do not use any pearlescent agents in their examples. However, the arguments are not persuasive because the rejection is not one '862 and '345 patents alone. It is argued that '704 teaches only 5% brown nacre. Instant claims are not limited to any particular pearlescent agent and thus encompass the nacre of '704. With respect to the amount of brown nacre, applicants have not shown any unexpected advantage with 10% or 50% pearlescent (or nacre brown) agent claimed as opposed to 5% of '704. As explained above, the ranges tested are not compared with closest prior art to show the unexpected advantage. Hence, the argument that 5% nacre of '704 teaches away is not persuasive.

It is argued that '375 teaches pearlescent agent with water that is not claimed in the instant. However, instant claims as presented do not distinguish

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from the pearlescent agent of '375. The comparative examples do not specify the absence of water in pearlescent agents nor did applicants provide any comparison of such agents with and without water. Further, instant comprising language allows for the presence of water in the pearlescent agents. Hence the arguments are not persuasive.

Applicants argue that '354 would lead a person of skill in the art away from using non-transparent pearlescent agents. See col. 1, l1.41-50. Applicants respectfully submit that the '354 patent contains no teaching of using pearlescent agents generally in high amounts, and a person of skill in the art would not combine this reference with '704, '862 and '345 patents in the manner suggested by the examiner given the unpredictability in the art.

Applicants arguments are not persuasive because '354 patent also teaches cosmetic composition comprising pearlescent pigments confers excellent cosmetic properties such as pearliness and smoothness (col. 1), the same effect which is also intended in the instant invention. The argument that the increased amounts of pearlescent agent necessitates the amount of binder due to cohesion, which teaches away from using non-transparent agents is not persuasive because instant claims do not recite non-transparent pearlescent agents and applicants have not shown that the amounts of the two components that impart the problems of cohesion are not within the claimed scope.

EP '930 and JP 717 in view of '375 or '354

Applicants' arguments regarding the lack of prima facie obviousness over the teachings of '375 and '354 have been addressed above. It is argued that the Examiner asserts that JP '717 teaches a solid cosmetic composition comprising from 0.1 to 50% by weight of organopolysiloxane. See Office Action at 11.

Applicants submit that JP '717 is completely silent with respect to the use of pearlescent agents, let alone teaching an amount ranging from 10% to 50% by weight, relative to the total weight of the composition. Further, it fails to provide any guidance with respect to the desirability of using pearlescent agents in an amount in the claimed range, and fails to provide a reasonable expectation of success in arriving at the claimed invention. As discussed above, EP '930 (the '345 patent), the '375 patent and the '354 patent fail to provide a reasonable expectation of success for a person of ordinary skill to arrive at the presently claimed invention. Moreover, EP 930 (the '345 patent) in combination with the '375 or '354 patents fails to rectify the deficiency of JP '717 as it does not teach or suggest the claimed range or pearlescent agents beyond the specific types of the pearlescent agents in the '375 and '354 patents, and fails to provide a reason for a person of ordinary skill in the art to go beyond its disclosure to arrive at the claimed invention. Therefore, JP '717 in view of EP 930 and in view of the '375 or '354 patents does not establish a prima facie case of obviousness.

Applicants' arguments are not persuasive because EP '930 (evidenced by '345 patent) teaches the claimed components and also teaches the amounts of the components in terms of percentages and not ratios. Examiner explained in the preceding paragraphs how and why the teachings of US 345 patent render

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instant claims prima facie obvious even in light of the declaration. With respect to JP '717, the rejection clearly admits that JP fails to teach the particulate phase of the instant and relies on the teachings of EP 930 ('345) for the same. The motivation to include the particulate materials of EP 930 in the composition of JP 717 comes from the analogous nature of the both the references, directed to cosmetic foundations, powders, pastes, solid stick etc. EP 930 (345 patent) suggests that the particulate fillers provide modified texture to the composition and pigments impart color to the composition. US 345 suggests that the composition comprising organosiloxane, fibers and particulate fibers can be made a paste, powders etc., and provide a homogenous, uniform make-up with sharp contours when applied, accompanied by and also renders matte-effect and water resistant properties. Thus, the resulting composition of JP and EP provides the claimed paste to a pulverulent texture depending on the amounts of the individual components employed.

Obviousness double patenting rejection:

Applicants argue that because '345 was filed before the instant application, "one-way" test of obviousness is used to determine "whether the invention defined in a claim in the application is an obvious variation of the invention defined in a claim" in the '345 patent. See MPEP § 804 II.B.1 .(a) (citing In re Berg, 46 U.S.P.Q.2d 1226 (Fed. Cir. 1998)). The proper application of this test, in light of the established general principles for obviousness, reveals that pending claims 1-4, 8-20, 22, 25-51, and 57-63 of this application are not obvious over claims 1-63 of the '345 patent in view of the '375 or '354 patents.

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Applicants arguments regarding one-way test have been considered but are not persuasive because the rejection is made over '345 in view of '375 and '354. All of the references are failed before the instant and the rejection provides the motivation to modify the claims in view of '375 and '354.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S. Channavajjala whose telephone number is 571-272-0591. The examiner can normally be reached on 9.00 AM - 5.30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila G. Landau can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lakshmi S Channavajjala/
Primary Examiner, Art Unit 1611
June 18, 2010